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BIENEMAN, CHARLES A

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2176

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/388,351	SNAPPER ET AL.	
	Examiner	Art Unit	
	Charles A. Bieneman	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 September 1999 and 09 December 1999.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-55 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-55 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 01 September 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This action is responsive to the following communications: original application filed on September 1, 1999 and Information Disclosure Statement filed on December 9, 1999.
2. Claims 1-55 are pending. Claims 1, 16, 21, and 29 are independent claims.

Information Disclosure Statement

3. As indicated on the attached copy of form PTO-1449, three references cited in the Information Disclosure Statement filed on December 9, 1999 have not been considered because the dates of the references could not be ascertained. The only date given on these references is either a 1999 copyright or a date subsequent to applicants' filing date that appears to be the date on which the document was printed, not the date on which it was published.

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.
6. The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2176

8. **Claim 49** recites the limitation "a previously stored URL" in line 10. There is insufficient antecedent basis for this limitation in the claim inasmuch as none of claims 16, 48, or 49 recite storing a URL prior to undertaking the step recited in claim 49.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. **Claims 1, 3, 29, 31, and 45** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,208,339 B1 to Atlas et al., issued March 27, 2001, filed June 19, 1998.

Regarding **independent claim 1**, Atlas et al. disclose (1) displaying on a computer screen a form comprising a plurality of fields, each field having a field identifier and a data entry region into which a data value can be written. (Atlas et al., Figs. 2-7.)

Further, Atlas et al. disclose (2) determining that a user has selected one of the plurality of fields. (Atlas et al., col. 5, line 62, col. 6, line 3: "At this point, step 99, the user will go to each entry field in sequence. For each, a determination is made as to whether the autocomplete is on, decision step 100. If Yes, then, step 101, the entry is made using the autocomplete function;

if No, then the user makes the full entry without autocomplete, step 102. When in decision step 103 it is determined the last entry has been made, the session is completed and exited.”)

Further, Atlas et al. disclose (3) comparing the field identifier of the selected field to previously stored field identifiers inasmuch as Atlas et al. teach that data entry fields are supported by libraries; thus the autocomplete function would have inherently required comparing the field identifier of the selected field to previously stored field identifiers. Further, Atlas et al. disclose upon finding a match, displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user. (Atlas et al., Fig. 7; see Dialog Box 65, “Show relevant list of items as pop-up” option.)

Further, Atlas et al. discloses (4) in response to the user selecting one of the suggested data values, copying the selected on data value into the data entry region of the selected field. (Atlas et al., col. 5, lines 65-67: “If Yes, then, step 101, the entry is made using the autocomplete function.”)

Further, Atlas et al. disclose (5) in response to the user entering a non-suggested data value, storing the non-suggested data value into a data storage area for future use. (Atlas et al., Fig. 7, Dialog Box 65; col. 4, lines 51-60: “Of course, the user may wish to change the mode of operation of the autocomplete function by modifying any of a variety of autocomplete properties. In such a situation he would bring up a more elaborate dialog box 65, as shown in FIG. 7, from which several properties may be modified, such as when in the entry autocomplete kicks in, the order of display, e.g. based on frequency or completely alphabetically, whether single or multiple proposed entries for the field are presented and how items are to be added to the database or library which provides proposed entries.”)

Regarding **independent claim 29**, a computer-readable medium containing instructions for performing the same steps recited in claim 1, the rejection of claim 1 above is fully incorporated herein.

Further, Atlas et al. teach a computer-readable medium. (Atlas et al., Fig. 1.)

Regarding **dependent claims 3 and 31**, it is inherent in Atlas et al.'s disclosure of a pop-up box, as discussed above regarding claim 1, that a user initiated action (*i.e.*, selecting a suggested data value from the pop-up box) would be detected and that the system would be inhibited from pasting a suggested value into the form field until after receiving the user-initiated action.

Regarding **dependent claim 45**, Atlas et al. inherently disclose permitting the user to delete one of the previously stored suggested data values inasmuch as they teach allowing the user to edit the list of previously stored suggested data values. (Atlas et al., Fig. 7, Dialog Box 65.)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,794,259 to Kikinis, issued August 11, 1998, in view of U.S. Patent Number 6,192,380 B1 to Light et al., issued February 29, 2001, filed March 31, 1998.

Regarding **independent claim 1**, Kikinis discloses (1) displaying on a computer screen a form comprising a plurality of fields, each field having a field identifier and a data entry region into which a data value can be written. (Kikinis, Figs. 1, 2.)

Further, Kikinis discloses (2) determining that a user has selected one of the plurality of fields. (Kikinis, col. 4, lines 15-20: "It will be apparent to those with skill in the art that there are a variety of ways the bubble feature may be activated. For example, the code could be provided so one may move the conventional screen cursor to a field and provide the activating signal by a hot key, displaying the bubble."); col. 4, lines 29-31: "In an alternative embodiment the bubble may be invoked at the first use of the control code, and used with the "Normal Fill" selection to fill fields one at a time.")

Further, Kikinis discloses (3) comparing the field identifier of the selected field to previously stored field identifiers and, upon finding a match, displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user. (Kikinis, col. 3, lines 66-67: "The code executing matches field names in the form with tags to the prestored information about the user . . ."); col. 4, lines 7-10: "a preferred embodiment another Hot Key or key combination, or key and mouse button combination causes the control code executing to display a bubble 210 having a selection list 212 of tags for prestored information.")

Further, Kikinis discloses (4) in response to the user selecting one of the suggested data values, copying the selected on data value into the data entry region of the selected field. (Kikinis, col. 4, lines 22-25: "Any one of a variety of mechanisms might be incorporated for

Art Unit: 2176

selection of a highlighted item in the list, which then is inserted into the field to which the bubble points.”)

Further, Kikinis does not disclose (5) in response to the user entering a non-suggested data value, storing the non-suggested data value into a data storage area for future use. However, Light et al. teaches adding to a database a form field identifier and the data entered in the form either automatically or in response to a user query when that information was not previously found in the database. (Light et al., col. 7. lines 11-19.) Moreover, one of ordinary skill in the art would have been motivated to implement such a step because it would have clearly increased the efficiency of filling out the form to have field values remembered the next time the user encountered the form, and because the field identifier would have assisted in locating the data the next time it was needed, and the data value entered in the form would have been needed to fill out the form the next time it was presented. Therefore, it would have been obvious to one of ordinary skill in the art to have extended Kikinis to implement step (5).

Regarding **independent claim 29**, a computer-readable medium containing instructions for performing the same steps recited in claim 1, the rejection of claim 1 above is fully incorporated herein.

Further, Kikinis inherently teaches a computer-readable medium inasmuch as Kikinis teaches a CPU capable of executing code. (Kikinis, col. 1, lines 59-67.)

13. **Claims 2 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis and Light et al. as applied to claim 1 above, and further in view of U.S. Patent Number 6,199,079 to Gupta et al., issued March 6, 2001, filed March 20, 1998.

Kikinis does not disclose storing the non-suggested data value, the field identifier, or a URL for the web site from which the form was generated. However, as noted above regarding claim 1, it would have been obvious over Kikinis in view of Light et al. to have stored the non-suggested data value and field identifier. Moreover, Gupta et al. teach using a web site's URL to determine when a particular form has been encountered (Gupta et al., col. 8, lines 26-27), which would have suggested to one of ordinary skill in the art to store the URL for the web site from which the form was generated because one of ordinary skill in the art would have recognized that the URL of a web site containing a form provides a simple and direct means for associating form data with the form in which the data are to be entered. Therefore, it would have been obvious to one of ordinary skill in the art to have stored a URL for the web site from which the form was generated, and further it would have been obvious to one of ordinary skill in the art to have combined Kikinis, Light et al., and Gupta et al. to store the non-suggested data value, the field identifier, and a URL for the web site from which the form was generated.

14. **Claims 2, 4-5, 30, 32, 43-44, and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. as applied to claims 1 and 29 above, and further in view of Gupta et al.

Regarding dependent claims 2 and 30, Atlas et al. do not disclose storing a URL for the web site from which the form was generated. However, as discussed above regarding claim 1, Atlas et al. do disclose storing a data value and in addition it is inherent in storing the data value for future use to have stored a field identifier inasmuch as the data value would have been identified in the database by means of a field identifier. Moreover, Gupta et al. teach using a web site's URL to determine when a particular form has been encountered (Gupta et al., col. 8,

Art Unit: 2176

lines 26-27), which would have suggested to one of ordinary skill in the art to store the URL for the web site from which the form was generated because one of ordinary skill in the art would have recognized that the URL of a web site containing a form provides a simple and direct means for associating form data with the form in which the data are to be entered. Therefore, it would have been obvious to one of ordinary skill in the art to have stored a URL for the web site from which the form was generated, and further it would have been obvious to one of ordinary skill in the art to have combined Atlas et al. and Gupta et al. to store the non-suggested data value, the field identifier, and a URL for the web site from which the form was generated.

Regarding **dependent claim 4**, Atlas et al. do not teach displaying a web page using an Internet web browser or comparing the selected field identifier with previously stored field identifiers in the web browser. However, Gupta et al. teach displaying a web page in a browser. (Gupta et al., col. 6, lines 3-10.) Moreover, Atlas et al. teach the comparison of step (3) taking place in an application analogous to a web browser. (Atlas et al., col. 5, lines 17-23: “These autocomplete functions are supported by a library of proposed completed entries for each of the data entry fields, step 83; such libraries of terms are usually stored on the hard disk drive of the system, e.g. storage device 20, FIG. 1, and then moved into the main memory 14 of the computer when needed to support the operation of the autocomplete program.”) Further, Atlas et al. provided motivation for one of ordinary skill in the art to implement their invention in a web browser inasmuch as they cite the growth of computer usage spurred by the Internet as one of the factors making their invention advantageous. (Atlas et al., col. 1, lines 14-27.) Therefore, it would have been obvious to one of ordinary skill in the art to have implemented steps (1) and (3) in a web browser.

Art Unit: 2176

Regarding **dependent claims 5 and 32**, Atlas et al. do not teach comparing the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displaying the suggested data values having the same URL. However, Gupta et al. teach a form's URL as a criterion for selecting form data (Gupta et al., col. 8, lines 26-27), which would have suggested the step recited in claim 5 to one of ordinary skill in the art because such a person would have recognized that field identifiers having the same URL were likely to represent the same fields on the same form. Therefore, it would have been obvious to one of ordinary skill in the art to have compared the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displayed the suggested data values having the same URL.

Regarding **dependent claim 43**, Atlas et al. do not teach inhibiting display of suggested data values for password fields unless the URL from which the form was generated matches a previously stored URL. However, in light of the obviousness over Atlas et al. of comparing URLs when comparing field identifiers, noted regarding claims 5 and 32 above, it likewise would have been obvious to display suggested password values only when matching URLs could be found because one of ordinary skill in the art would have recognized that passwords could have been different from site to site.

Regarding **dependent claim 44**, Atlas et al. do not explicitly teach computer-executable instructions comprising an Internet web browser displaying web pages and providing web navigation functions. However, Gupta et al. teach displaying a web page in a browser. (Gupta et al., col. 6, lines 3-10.) Further, Atlas et al. provided motivation for one of ordinary skill in the art to implement their invention in a web browser inasmuch as they cite the growth of computer

Art Unit: 2176

usage spurred by the Internet as one of the factors making their invention advantageous. (Atlas et al., col. 1, lines 14-27.) Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the computer-readable medium as recited in claim 44.

Regarding **dependent claim 54**, the combination of Atlas et al. and Gupta et al. does not teach prompting the user to indicate whether a password field should be stored for a URL when no indication to store a password has been previously indicated. However, it would have been obvious to one of ordinary skill in the art to have so prompted the user because one of ordinary skill in the art would have recognized that the user might not want the password automatically stored because the user might not have wanted to give others access to the password and also would have recognized that if the user had not previously stored the password the reason might be that the user had not yet had the opportunity to do so, and did in fact want the password stored.

15. **Claims 6-7, 15, 33-34, and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. as applied to claim 1 above, and further in view of Light et al.

Regarding **dependent claims 6 and 33**, Atlas et al. do not teach step (3) comprising the step of comparing the field identifier of the selected field to a first plurality of dynamically updated historical identifiers and also to a second plurality of statically created identifiers and displaying suggested data values taken from both sources. However, Light et al. teach storing identifiers from both sources. (Light et al., col. 4, lines 32-36: "Generally, the user will wish to initially enter the personal information to be filled into the various forms. Alternatively, this step may be skipped, and the system may only learn from user input, as will be described below."; see also col. 7, lines 11-19.) One of ordinary skill in the art would have recognized that using

Art Unit: 2176

identifiers both from a statically created profile and extracted from various web sites would have conferred the benefit of providing the greatest likelihood that one of the suggested data values would in fact be the data value that the user wished to insert into the form. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the steps recited in claims 6 and 33.

Regarding **dependent claims 7 and 34**, Atlas et al. teach comparing the field identifier of the selected field to a statically created common names data store comprising frequently used field identifiers that are mapped to one or more field identifiers in the user profile. (Atlas et al., col. 4, lines 47-51: "At block 440, the user is requested to enter further tags associated with the data. Thus, for example, when the user enters his or her first name, in response to a tag asking for a "first name", the user may add other tags, such as "given name", etc."); col. 5, lines 61-65: "At block 525, the tag is matched to a list of tags in the database. The database includes all of the tags originally supplied, tags entered by the user, and tags learned, as will be discussed later. The extracted tag is compared to the tags in the database.")

Regarding **dependent claims 15 and 42**, Atlas et al. do not teach comparing the field identifier of the selected field to previously stored field identifiers that reside on a web site different from the computer on which the form is displayed. However, Light et al. inherently teach such a step inasmuch as they disclose storing field identifiers from whatever web site the user happens to be visiting, and then comparing the field identifier of the selected field to the stored field identifiers. (Light et al., col. 7, lines 11-19; col. 5, lines 61-65.) Moreover, one of ordinary skill in the art would have been motivated to implement such a step because comparing field identifiers from multiple websites would have increased the likelihood that a suggested

Art Unit: 2176

value could be found. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited in claim 15.

16. **Claims 8 and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. and Light et al. as applied to claims 7 and 33, respectively, above, and further in view of applicants' specification.

Atlas et al. do not teach comparing the field identifier of the selected field to field identifiers in a statically created standard vCard schema. However, applicants disclose in the specification (page 2, line 21) that the standard vCard schema was known in the art prior to applicants' invention. One of ordinary skill in the art would have recognized the benefit of being able to compare selected field identifiers to field identifiers in a schema conforming to an established standard. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited in claims 8 and 35 respectively.

17. **Claims 9-14, 36-41, 46, and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al.

Regarding **dependent claims 9 and 36**, Atlas et al. teach showing suggested data values in a pop-up list (Atlas et al., Fig. 7), but are silent as to where the physical list is displayed (e.g., above or below) with regard to the form field. However, one of ordinary skill in the art would have recognized the benefit of locating the list below the form field so as not to obscure previously-completed fields above. Therefore, it would have been obvious to one of ordinary skill in the art to have displayed a pop-down list of suggestions.

Further, it is inherent in Atlas et al.'s disclosure of displaying suggested values in a pop-up that the user would be able to navigate through the disclosed pop-up with a mouse (taught at

Art Unit: 2176

col. 3, line 38), and that the pop-up would have been removed after the user had made a selection. Alternatively, to the extent these elements are not inherently disclosed by Atlas et al., they would have been obvious to one of ordinary skill in the art because a user would have needed some means to navigate through the list to select the desired value, and further the user would not have wanted to see the list after the desired value had been selected.

Regarding **dependent claims 10 and 37**, Atlas et al. do not teach providing an extendable corner tab permitting the pop-down list to be resized by the user. However, one of ordinary skill in the art would have recognized that such a tab would permit the user to re-size the list as needed when suggested values exceeded the size of the list as displayed by default. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited in claims 10 and 37.

Regarding **dependent claims 11 and 38**, Atlas et al. teach providing the user with an option to globally disable future storage of field data values. (Atlas et al., Fig. 7: see “Add no new entries” option in Dialog Box 65.)

Regarding **dependent claims 12 and 39**, Atlas et al. teach providing the user with an option to disable storage of field data values on a field-by-field basis. (Atlas et al., Fig. 7: see “Prompt me before adding new entries” option in Dialog Box 65.)

Regarding **dependent claims 13 and 40**, Atlas et al. do not teach detecting a password field and forcing a user to select whether the data value therein will be stored for later use. However, notice is taken that at the time of applicants’ invention HTML 4.0 provided a form element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed. Accordingly, one of ordinary skill in the art would

Art Unit: 2176

have recognized that the user may not have wanted to save a password in a place where it might accessible for use by other users. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited in claims 13 and 40.

Regarding **dependent claims 14 and 41**, Atlas et al. do not teach detecting a credit card number field and suppressing suggestions in response thereto. However, notice is taken that at the time of applicants' invention HTML 4.0 provided a form element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed, and that this masking equally could have been applied to credit card numbers. Moreover, one of ordinary skill in the art would have recognized that the user would not have wanted to save a credit card number in a place where it might accessible for use by other users. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the step recited in claims 14 and 41.

Regarding **dependent claims 46 and 52**, Atlas et al. do not teach detecting a username field and then automatically copying a password previously used in response to the username into a password field. However, such a step would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art would have recognized that that usernames and passwords are generally associated with each other.

18. **Claims 16-17, 19-20, 48-49, and 55** are rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. in view of Atlas et al.

Regarding **independent claim 16**, Light et al. teach (1) displaying on the user's computer a first form comprising a first plurality of text fields each comprising a field identifier and a data

Art Unit: 2176

entry region into which a data value can be written. (Light et al., col. 2, lines 53 – col. 3, line 17.)

Further, Light et al. teach (2) entering a data value into one of the first plurality of text fields and storing the entered data value into a database. (Light et al., col. 7, lines 11-19.) Light et al. do not disclose storing the entered data into a local storage area on the user's computer. However, Atlas et al. teach storing suggested values on the user's computer (Atlas et al., col. 5, lines 17-23: "These autocomplete functions are supported by a library of proposed completed entries for each of the data entry fields, step 83; such libraries of terms are usually stored on the hard disk drive of the system, e.g. storage device 20, FIG. 1, and then moved into the main memory 14 of the computer when needed to support the operation of the autocomplete program."), which would have suggested to one of ordinary skill in the art to store entered data on the user's local computer because such a step would have made data readily available without risking the potential inefficiencies of accessing data through a network. Therefore, it would have been obvious to one of ordinary skill in the art to have entered a data value into one of the first plurality of text fields and storing the entered data value into a local storage area on the user's computer.

Further, Light et al. disclose (3) displaying a second form comprising a second plurality of text fields comprising field identifiers different from those in the first form inasmuch as Light et al. teach that their invention is embodied in a web browser that visits a plurality of web pages (Light et al., col. 2, lines 53-62).

Further, Light et al. teach (4) detecting whether one of the text fields in the second form is correlated with one of the text fields on the first form despite having a different field identifier,

Art Unit: 2176

and retrieving a correspondingly previously stored data value in response thereto. (Light et al., col. 6, lines 61-67: “At block 590, the system queries whether the data filled in matches information in the database. This is applicable if a different tag is used by the web page for known data. For example, the tag ‘Christian name’ may be used in a foreign web page, for the data tagged ‘first name’ in the database. The data entered by the user would still be ‘John’, or the appropriate first name.”)

Further, Light et al. do not teach suggesting the data value retrieved in step (4) to the user as a possible value to be entered into the second form. However, Atlas et al. disclose upon finding a match, displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user. (Atlas et al., Fig. 7; see Dialog Box 65, “Show relevant list of items as pop-up” option.) One of ordinary skill in the art would have recognized that such a step would have provided the benefit of allowing the user to determine whether a suggested value was appropriate instead of inserting a matched value that might be wrong, or not offering the user any value at all. Therefore, it would have been obvious to one of ordinary skill in the art to have extended Light et al. to implement step (5).

Regarding **dependent claim 17**, as noted above regarding claim 16, Light et al. teach generating a plurality of forms from a plurality of web sites.

Regarding **dependent claim 19**, Light et al. do not teach retrieving and displaying in a list previously stored data values. However, Atlas et al. do teach such a step. (Atlas et al., Fig. 7.) One of ordinary skill in the art would have recognized that such a step would have provided the benefit of allowing the user to determine whether a suggested value was appropriate instead of inserting a matched value that might be wrong, or not offering the user any value at all.

Art Unit: 2176

Therefore, it would have been obvious to one of ordinary skill in the art to have extended Light et al. to implement the step recited in claim 19.

Regarding **dependent claim 20**, Light et al. teach inhibiting the release of the suggested data value until the user has manipulated a user input device. (Light et al., col. 6, lines 25-29: “At block 550, the user is queried whether it is acceptable to fill-in the data.”)

Regarding **dependent claim 48**, Light et al. do not teach detecting a username field and then automatically copying a password previously used in response to the username into a password field. However, such a step would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art would have recognized that that usernames and passwords are generally associated with each other.

Regarding **dependent claim 49**, Light et al. do not teach do not teach inhibiting display of suggested data values for password fields unless the URL from which the form was generated matches a previously stored URL. However, it would have been obvious to one of ordinary skill in the art to have displayed suggested password values only when matching URLs could be found because one of ordinary skill in the art would have recognized that passwords could have been different from site to site.

Regarding **dependent claim 55**, Light et al. do not teach prompting the user to indicate whether a password field should be stored for a URL when no indication to store a password has been previously indicated. However, it would have been obvious to one of ordinary skill in the art to have so prompted the user because one of ordinary skill in the art would have recognized that the user might not want the password automatically stored because the user might not have wanted to give others access to the password and also would have recognized that if the user had

Art Unit: 2176

not previously stored the password the reason might be that the user had not yet had the opportunity to do so, and did in fact want the password stored.

19. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. and Atlas et al. as applied to claim 16 above, and further in view of applicants' specification.

Neither Light et al. nor Atlas et al. teach using Bayesian inference techniques. However, as applicants admit beginning at line 21 on page 20 of their specification, Bayesian inference techniques were well known in the art at the time of applicants' claimed invention. Moreover, one of ordinary skill in the art would have been motivated to use Bayesian inference techniques to determine whether two form fields were correlated because such techniques predict probabilities; *i.e.*, if there was a high probability that two form fields matched, then one would probably want to use a value from the first field in filling in the second. Therefore, it would have been obvious to one of ordinary skill in the art to have extended the combination of Light et al. and Atlas et al. to use Bayesian inference techniques.

20. **Claims 21-22, 24, 26-28, and 50-51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. in view of Light et al.

Regarding **independent claim 21**, Atlas et al. disclose a computer system comprising a processing unit, a memory, a display unit, and an interface to a network. (Atlas et al., Fig. 1.)

Atlas et al. do not explicitly teach a web browser. However, Light et al. teach use of a web browser. (Light et al., col. 2, lines 53-62.) Further, Atlas et al. provided motivation for one of ordinary skill in the art to implement their invention in a web browser inasmuch as they cite the growth of computer usage spurred by the Internet as one of the factors making their invention advantageous. (Atlas et al., col. 1, lines 14-27.) Therefore, it would have been obvious to one of

Art Unit: 2176

ordinary skill in the art to have extended Atlas et al. to include a web browser in the system taught therein.

Further, the rejection of claim 1 above as being anticipated by Atlas et al. is fully incorporated herein.

Regarding **dependent claim 22**, it is inherent in Atlas et al.'s disclosure of a pop-up box (Atlas et al., Fig. 7), that a keystroke or mouse click (*i.e.*, selecting a suggested data value from the pop-up box) would be detected and that the system would be inhibited from pasting a suggested value into the form field until after receiving the keystroke or mouse click.

Regarding **dependent claim 24**, that claim is rejected for the same reasons given above for the rejection of claim 6 over Atlas et al. in view of Light et al.

Regarding **dependent claim 26**, that claim is rejected for the same reasons given above for the rejection of claim 9 over Atlas et al.

Regarding **dependent claim 27**, Atlas et al. teach providing the user with an option to disable storage of field data values on a field-by-field basis. (Atlas et al., Fig. 7: see "Prompt me before adding new entries" option in Dialog Box 65.)

Regarding **dependent claim 28**, that claim is rejected for the same reasons given above for the rejection of claim 15 over Atlas et al. in view of Light et al.

Regarding **dependent claim 50**, Atlas et al. do not teach detecting a username field and then automatically copying a password previously used in response to the username into a password field. However, such a step would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art would have recognized that that usernames and passwords are generally associated with each other.

Regarding **dependent claim 51**, Atlas et al. do not teach detecting a username field and then automatically copying a password previously used in response to the username into a password field. However, such a step would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art would have recognized that that usernames and passwords are generally associated with each other.

21. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. and Light et al. as applied to claim 21 above, and further in view of Gupta et al.

Atlas et al. and Light et al. do not disclose comparing field identifiers having the same URL and displaying suggested values based on the comparison. However, for the reasons stated above regarding the rejection of claim 3 over Atlas et al. in view of Gupta et al. it would have been obvious to one of ordinary skill in the art to have combined Atlas et al., Light et al., and Gupta et al. to have the web browser perform the step recited in claim 23.

22. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. and Light et al. as applied to claim 21 above, and further in view of applicants' specification, under the same rationale given above regarding the rejection of claim 8 over Atlas et al. in view of Light et al.

23. **Claims 47 and 53** are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas et al. as applied to claims 46 and 52, respectively, above, and further in view of Gupta et al. under the same rationale given above regarding the rejection of claim 43 over Atlas et al. in view of Gupta et al.

Double Patenting

24. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 2176

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

25. **Claims 1, 16, 21, and 29** are provisionally rejected under the judicially created doctrine of double patenting over claims 8, 15, and 21 of copending Application No. 09/388,353. **Claims 4, 21-28, 30, 32-33, 42-44, 47, 49-51, 53-55** are provisionally rejected under the judicially created doctrine of double patenting over claims 5, 12, and 15-20 of copending Application No. 09/388,353. These are provisional double patenting rejections since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Regarding **claims 1, 16, 21, and 29**, and claims 8, 15, and 21 of copending Application No. 09/388,353, each essentially recites the same steps and/or elements inasmuch as they each recite a user entering data in a form field, saving the data to storage, and then using the previously stored data to suggest or provide values to be filled into subsequently presented form fields.

Regarding claims 4-5, 21-28, 30, 32-33, 42-44, 47, 49-51, 53-55, claims 5, 12, and 15-20 of copending Application No. 09/388,353, each essentially recites identifying and comparing form fields in HTML pages.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Number	Name	Issue Date	File Date	
6,421,693 B1	Nishiyama et al.	7/16/02	10/15/98	
6,247,029 B1	Kelley et al.	6/12/01	5/1/98	
6,088,700	Larsen et al.	6/11/00	8/6/99	
5,666,502	Capps	9/6/97		

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB

November 22, 2002

Heather
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